#8/Election/Appeal
5-23-01
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Kenji Sakamoto

Group Art Unit: 1653

Examiner: S. Chunduru

Serial No.: 09/647,705

Filed: November 7, 2000

For: **METHOD FOR SEARCHING PHYSIOLOGICALLY ACTIVE SUBSTANCES, PROCESS FOR PRODUCING THESE SUBSTANCES AND DRUGS FOUND BY THE SEARCHING METHOD**

Attorney Docket No.: IKU 0104 PUSA

RESPONSE TO RESTRICTION REQUIREMENT AND SUBMISSION OF SEQUENCE LISTING

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This is a response to the Restriction Requirement of April 19, 2001. Applicant elects without traverse to prosecute Group No. 1 comprising Claims 1-4 drawn to a method for searching physiologically active substances.

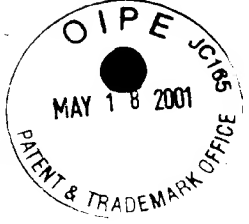
CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Commissioner for Patents, United States Patent and Trademark Office, Washington, D.C. 20231 on:

May 16, 2001 — Date of Deposit

James N. Kallis — Name of Person Signing

J. Kallis — Signature



The Examiner requires that the Applicant specify one specific polypeptide sequence for examination. It is respectfully submitted that the Patent Office has not complied with MPEP § 803.04 which states:

> Each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. § 121 and 35 C.F.R. § 1.141 *et seq.* Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. § 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single patent application . . . It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction.

Applicant's invention contains six polypeptide sequences, which the Commissioner considers reasonable for examination purposes. Thus, although Applicant has elected Group 1 for examination, the Restriction Requirement under 35 U.S.C. § 121 for the polypeptide sequences should be waived. If the Examiner continues to require election of a single sequence, Applicant elects Sequence I.D. No. 1.

SUBMISSION OF SEQUENCE LISTING

In the communication from the Examiner mailed April 19, 2001, the Examiner required compliance with Sequence Rules 37 C.F.R. 1.821-1.825 before this application could be examined under 35 U.S.C. § 131 and 132. Applicant has prepared and submitted a Sequence Listing in both written and computer readable form as well as a statement that no new matter has been added, in compliance with 37 C.F.R. 1.821-1.825.

Prompt and favorable consideration of this application is requested. If the Examiner notes any minor errors, he is invited to telephone the undersigned so that the matter can be promptly handled by Examiner's amendment.

Respectfully submitted,

Kenji Sakamoto

By: _____

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Date: May 16, 2001

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